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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,609	07/26/2001	William Alexander McEwan	NA11P017/01.062.01	8706
28875	7590	03/01/2005		
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			EXAMINER INGBERG, TODD D	
			ART UNIT	PAPER NUMBER
			2124	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,609

Applicant(s)

MCEWAN, WILLIAM ALEXANDER

Examiner

Todd Ingberg

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/4/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

42

## DETAILED ACTION

Claims 1 – 31 have been examined.

### *Information Disclosure Statement*

1. The Information Disclosure Statement (IDS) filed September 4, 2001 has been considered.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Legal words like Method and System should be removed from the title.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter is concrete and useful but not tangible as currently claimed. The Examiner has provided one way to overcome this rejection.

#### Claim 1

A method for testing scanner updates **executing on a computer and stored on a computer readable medium**, comprising:

- (a) distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) executing the full-release scanner update on the computers for security scanning;
- (d) executing the pre-release scanner update on the computers for testing purposes; and
- (e) transmitting results of the testing from the computers to the server utilizing the network.

#### Claim 27

Art Unit: 2124

A computer program product for testing scanner updates **executing on a computer and stored on a computer readable medium**, comprising:

- (a) computer code for distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) computer code for distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) computer code for executing the full-release scanner update on the computers for security scanning;
- (d) computer code for executing the pre-release scanner update on the computers for testing purposes; and
- (e) computer code for transmitting results of the testing from the computers to the server utilizing the network.

Claim 28

A system for testing scanner updates **executing on a computer and stored on a computer readable medium**, comprising:

- (a) logic for distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) logic for distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) logic for executing the full-release scanner update on the computers for security scanning;
- (d) logic for executing the pre-release scanner update on the computers for testing purposes; and
- (e) logic for transmitting results of the testing from the computers to the server utilizing the network.

Claim 29

A server-based method for testing scanner updates **executing on a computer and stored on a computer readable medium**, comprising:

- (a) distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) receiving results of the execution of the full-release scanner update and the pre-release scanner update from the computers;
- (d) modifying the pre-release scanner update before releasing the pre-release scanner update as a full-release scanner update based on the results.

Claim 30

A client-based method for testing scanner updates **executing on a computer and stored on a computer readable medium**, comprising:

- (a) receiving from a server a full-release scanner update at a computer utilizing a network;
- (b) receiving from the server a pre-release scanner update at the computer utilizing the network;
- (c) executing the full-release scanner update on the computer for security scanning;
- (d) executing the pre-release scanner update on the computer for testing purposes; and

Art Unit: 2124

(e) transmitting results of the testing from the computer to the server utilizing the network.

Claim 31

A method for testing scanner updates executing on a computer and stored on a computer readable medium, comprising:

- (a) distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) distributing a pre-release scanner update from the server to the computers simultaneously with the full-release update utilizing the network;
- (c) executing the full-release scanner update on the computers for security scanning;
- (d) determining whether the computers are idle;
- (e) automatically executing the pre-release scanner update on the computers for testing purposes upon the computers being determined to be idle;
- (f) comparing results of the execution of the full-release scanner update and the pre-release scanner update;
- (g) determining whether a virus is detected by the execution of the pre-release scanner update and not by the full-release scanner update based on the comparison;
- (h) storing a record of the detected virus;
- (i) removing the detected virus;
- (j) detecting faults associated with the execution of the pre-release scanner update;
- (k) ceasing the execution of the pre-release scanner update on the computers in response to the detection of at least one fault;
- (l) re-executing the pre-release scanner update on the computers after ceasing the execution;
- (m) counting a number of the faults;
- (n) conditionally re-executing the pre-release scanner update on the computers if the number exceeds a predetermined number within a predetermined amount of time;
- (o) storing a record of the faults;
- (p) transmitting results relating to the viruses and faults from the computers to the server utilizing the network; and
- (q) modifying the pre-release scanner update at the server before releasing the pre-release scanner update as a full-release scanner update based on the results.

*Allowable Subject Matter*

4. In view of the prior art of record writing a sustainable rejection with the prior art of record in view of In re. Zurko prohibiting “basic Knowledge” or “Common Sense” is not supported by evidence in the prior art and lacks substantial evidentiary support.

The best prior art of record is Norton AntiVirus version 95 which teaches a complete commercial product from 1994 – 1995 when virus signatures are downloaded and viruses are scanned and

Art Unit: 2124

removed. Reports are generated and the operations take place over the Internet. No mention of the virus scanning downloads being "beta" releases (pre-release). Furthermore, despite the Internet communications the reference is silent as to client to server communications reporting information as found in the claims.

The Examiner attempted to correct these deficiencies with a portion of Norton AntiVirus 97 but was unable. The Examiner turned to USPN Fiske which has a means of determining if updates should be backed out based on counters. The Tso et al reference USPN 6,088,803 performed virus scanning and had some limited reporting. All references failed to explicitly mention the intent of beta testing the computer virus software and the limitations of when to run, reporting for quality assurance and reports to determine if beta to release is appropriate and the restarting of the beta testing. Taken singularly and in combination the references do not teach the claimed invention.

The claims in their entirety are listed below:

Claim 1

A method for testing scanner updates, comprising:

- (a) distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) executing the full-release scanner update on the computers for security scanning;
- (d) executing the pre-release scanner update on the computers for testing purposes; and
- (e) transmitting results of the testing from the computers to the server utilizing the network.

Claim 2

The method as recited in claim 1, wherein the full-release scanner update and the pre-release scanner update are distributed simultaneously.

Claim 3

The method as recited in claim 1, wherein the full-release scanner update and the pre-release scanner update are distributed together.

Art Unit: 2124

**Claim 4**

The method as recited in claim 1, wherein the pre-release scanner update is distributed on a periodic basis.

**Claim 5**

The method as recited in claim 1, wherein the pre-release scanner update is distributed with virus signatures.

**Claim 6**

The method as recited in claim 1, and further comprising automatically determining whether a pre-release scanner update exists, and conditionally distributing the pre-release scanner update from the server if the pre-release scanner update exists.

**Claim 7**

The method as recited in claim 1, wherein the pre-release scanner update is executed when the computers are idle.

**Claim 8**

The method as recited in claim 1, wherein the pre-release scanner update is executed automatically when the computers are idle.

**Claim 9**

The method as recited in claim 1, wherein the results are transmitted to a quality assurance administrator.

**Claim 10**

The method as recited in claim 1, and further comprising comparing results of the execution of the full-release scanner update and the pre-release scanner update.

**Claim 11**

The method as recited in claim 10, wherein the comparison occurs on the computers.

**Claim 12**

The method as recited in claim 11, and further comprising transmitting results of the comparison from the computers to the server utilizing the network.

**Claim 13**

The method as recited in claim 1, wherein the network includes the Internet.

**Claim 14**

The method as recited in claim 10, and further comprising determining whether a virus is detected by the execution of the pre-release scanner update and not the full-release scanner update based on the comparison.

Art Unit: 2124

Claim 15

The method as recited in claim 14, and further comprising removing the virus.

Claim 16

The method as recited in claim 14, and further comprising storing a record of the virus.

Claim 17

The method as recited in claim 14, and further comprising reporting the virus.

Claim 18

The method as recited in claim 1, and further comprising detecting faults associated with the execution of the pre-release scanner update.

Claim 19

The method as recited in claim 18, and further comprising transmitting a record of the faults from the computers to the server utilizing the network.

Claim 20

The method as recited in claim 18, and further comprising ceasing the execution of the pre-release scanner update on the computers in response to the detection of the faults.

Claim 21

The method as recited in claim 20, and further comprising re-executing the pre-release scanner update on the computers after ceasing the execution.

Claim 22

The method as recited in claim 18, and further comprising counting a number of the faults, and conditionally terminating the pre-release scanner update on the computers based on the number.

Claim 23

The method as recited in claim 22, wherein the faults include at least one of delays, failures, crashes, and false alarms.

Claim 24

The method as recited in claim 1, and further comprising detecting a duration of the execution of the pre-release scanner update.

Claim 25

The method as recited in claim 24, and further comprising transmitting a record of the duration from the computers to the server utilizing the network.

Claim 26



Art Unit: 2124

The method as recited in claim 1, and further comprising utilizing the results to modify the pre-release scanner update before releasing the pre-release scanner update as a full-release scanner update.

Claim 27

A computer program product for testing scanner updates, comprising:

- (a) computer code for distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) computer code for distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) computer code for executing the full-release scanner update on the computers for security scanning;
- (d) computer code for executing the pre-release scanner update on the computers for testing purposes; and
- (e) computer code for transmitting results of the testing from the computers to the server utilizing the network.

Claim 28

A system for testing scanner updates, comprising:

- (a) logic for distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) logic for distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) logic for executing the full-release scanner update on the computers for security scanning;
- (d) logic for executing the pre-release scanner update on the computers for testing purposes; and
- (e) logic for transmitting results of the testing from the computers to the server utilizing the network.

Claim 29

A server-based method for testing scanner updates, comprising:

- (a) distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) distributing a pre-release scanner update from the server to the computers utilizing the network;
- (c) receiving results of the execution of the full-release scanner update and the pre-release scanner update from the computers;
- (d) modifying the pre-release scanner update before releasing the pre-release scanner update as a full-release scanner update based on the results.

Claim 30

A client-based method for testing scanner updates, comprising:

- (a) receiving from a server a full-release scanner update at a computer utilizing a network;
- (b) receiving from the server a pre-release scanner update at the computer utilizing the network;
- (c) executing the full-release scanner update on the computer for security scanning;

Art Unit: 2124

- (d) executing the pre-release scanner update on the computer for testing purposes; and
- (e) transmitting results of the testing from the computer to the server utilizing the network.

Claim 31

A method for testing scanner updates, comprising:

- (a) distributing a full-release scanner update from a server to a plurality of computers utilizing a network;
- (b) distributing a pre-release scanner update from the server to the computers simultaneously with the full-release update utilizing the network;
- (c) executing the full-release scanner update on the computers for security scanning;
- (d) determining whether the computers are idle;
- (e) automatically executing the pre-release scanner update on the computers for testing purposes upon the computers being determined to be idle;
- (f) comparing results of the execution of the full-release scanner update and the pre-release scanner update;
- (g) determining whether a virus is detected by the execution of the pre-release scanner update and not by the full-release scanner update based on the comparison;
- (h) storing a record of the detected virus;
- (i) removing the detected virus;
- (j) detecting faults associated with the execution of the pre-release scanner update;
- (k) ceasing the execution of the pre-release scanner update on the computers in response to the detection of at least one fault;
- (l) re-executing the pre-release scanner update on the computers after ceasing the execution;
- (m) counting a number of the faults;
- (n) conditionally re-executing the pre-release scanner update on the computers if the number exceeds a predetermined number within a predetermined amount of time;
- (o) storing a record of the faults;
- (p) transmitting results relating to the viruses and faults from the computers to the server utilizing the network; and
- (q) modifying the pre-release scanner update at the server before releasing the pre-release scanner update as a full-release scanner update based on the results.

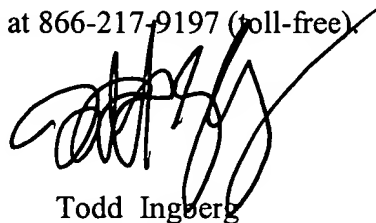
*Correspondence*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

Art Unit: 2124

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Todd Ingberg  
Primary Examiner  
Art Unit 2124

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